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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,581	08/25/2003	David B. Udy	20857.NP	4094
7590	06/24/2005		EXAMINER	
Starkweather & Associates 9035 South 1300 East Suite 200 Sandy, UT 84094			NOVOSAD, JENNIFER ELEANORE	
			ART UNIT	PAPER NUMBER
			3634	

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

V7

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/648,581	UDY, DAVID B.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jennifer E. Novosad	3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 August 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 22 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,7-9,12-17,22-24,27-33 and 35-37 is/are rejected.
- 7) Claim(s) 3-6,10,11,18-21,25,26, and 34 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 August 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/01/03; 6/6/05.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restriction*

Applicant's election with traverse of species (i), i.e., Figures 1-5, in the reply filed on April 7, 2005 is acknowledged. The traversal is on the ground(s) that "a plurality of tubes 44 can [be] disposed in the tapered enclosure... Enclosing the invention is not sufficiently different to trigger a patentably distinct species of the invention". This is not found persuasive because the examiner respectfully disagrees that the species of Figure 6 is not patentably distinct. *In particular*, as seen in Figure 2, applicant has shown a detailed and expanded view of one embodiment, while Figure 6 shows an embodiment that appears to not even be a modification of the embodiment shown in Figures 1-5. When the specification is reviewed with respect to Figure 6, the lines cited by the applicant are the only detailed reference of Figure 6, by itself. *Thus*, although applicant has attempted to argue the restriction requirement, from what can be seen in the drawings and read in the specification, the examiner stands behind the restriction requirement which is still deemed proper and is therefore made FINAL.

Claims 7 and 22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no *allowable* generic or linking claim.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 12, 13, 15, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Design Patent No. 169,077 (Mains, Jr. '077).

Mains, Jr. '077 discloses a storage device for tools comprising a plurality of receptacles arranged in a support (see Figure 1) in at least front (1<sup>st</sup> row in the front of Figure 1) and rear (3<sup>rd</sup> row from the front of Figure 1) substantially linear rows; each receptacle including at least a lower receiving port (see openings in the middle of Figure 2) and an upper receiving aperture (see openings in Figure 1); the receptacles of the front row being forwardly splayed at a forward angle with respect to vertical greater than the receptacles of the rear row (i.e., since the top surface of the device, is curved or slanted forwardly); the receptacles within each row being laterally splayed with respect to vertical with each row being oriented at progressively increasing lateral angles with respect to vertical from the center to lateral ends of each row (i.e., since the top surface of the device is curved outwardly between the enter and ends); attachment means (vertical bar-like structure seen in Figure 2) *for attaching the support to a structure*; the support including an upper frame (see Figure 1) and a lower frame (middle portion of Figures 2 and 3); *with respect to claim 13*, the device comprising a reinforcing plate (see Figure 4) disposed beneath the receptacles; the receptacles of the rear row are disposed at a higher elevation than those of the front row; the lower ports of the rear row having an elevation greater than the lower ports of the front row (see Figure 3); and *with respect to claim 14*, an auxiliary container (see Figure 4). Mains, Jr. '077 is also considered to show the structure capable of performing the method steps of attaching a tool storage device to a lower section of a structure (i.e., vertically extending bar-like element in Figure 2); *with respect to claim 31*, attaching the device flush (see

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bottom left corner of Figure 3) with the structure (vertically extending bar-like element in Figure 2) over an abutment (horizontally extending bar at the bottom left side of Figure 2) projecting from the structure.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9, 14, 23, 24, 27-29, 30-33, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mains, Jr. '077, alone.

Mains, Jr. '077 discloses the device as advanced above.

The claims differ from Mains, Jr. '077 in requiring: (a) the receptacle having a height of less than 12 inches, at least 5 receptacles disposed in a row that is less than 15 inches, and at least 2 rows disposed in a depth of less than 7 inches (claims 8, 23, and 32); (b) the support attached to an enclosure having a ceiling height of less than 8 feet (claims 9, 24, and 33); (c) an auxiliary container *removably attachable* to the support (claim 14 and 29); and (d) inserting a handle of an elongate tool into a receptacle (claim 16).

*With respect to (a)*, although Mains, Jr. '077 does not show the specified dimensions, it would have been an obvious design choice to one of ordinary skill in the art at the time the invention was made to have fabricated the device having the dimensions called for in the instant claims, for ease in economy and manufacture.

*With respect to (b)*, although Mains, Jr. '077 does not show the device being attached to such an enclosure, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attached the device to an enclosure for ease in use and increased organizational and storage capabilities.

*With respect to (c)*, although Mains, Jr. '077 does not show the container being *removably attachable* to the device, it would have been an obvious design choice to one of ordinary skill in the art at the time the invention was made to have provided the container such that it would be *removably attachable* for ease in use.

*With respect to (d)*, although Mains, Jr. '077 does not show a tool, the device is for holding tools, and thus it would have been obvious to one of ordinary skill in the art at the time the invention was made that an elongated tool could be placed therein, providing securement and stability thereto.

#### ***Allowable Subject Matter***

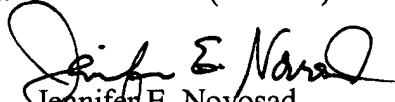
Claims 3-6, 10, 11, 18-21, 25, 26, and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Novosad whose telephone number is 571-272-6832. The examiner can normally be reached on Monday-Thursday, 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer E. Novosad  
Primary Examiner  
Art Unit 3634

June 22, 2005